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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/762,155	01/21/2004	James R. Combes	D/A0A23DD	4954

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100 Clinton Ave. S.
Rochester, NY 14644

EXAMINER	
FLETCHER III, WILLIAM P	

ART UNIT	PAPER NUMBER
1762	

DATE MAILED: 08/23/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/762,155	COMBES ET AL.	
	Examiner	Art Unit	
	William P. Fletcher III	1762	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *14 June 2006*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-29* is/are pending in the application.

4a) Of the above claim(s) *4,5,15,18 and 19* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-3,6-14,16,17 and 20-29* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *21 January 2004* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. This application is a DIV of 10/350,534, filed January 23, 2003, now US 6,743,559 B2, which is a DIV of 09/723,911, filed November 28, 2000, now US 6,673,501 B1.

Response to Amendment

2. Applicant's amendment and remarks filed June 14, 2006 are noted.

3. Claims 1-29 are pending.

Election/Restrictions

4. This application contains claims 4, 5, 15, 18, and 19, drawn to an invention nonelected with traverse in the response filed February 20, 2006. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

Response to Arguments

5. Applicant's arguments, see the remarks, filed June 14, 2006, with respect to the objections set-forth in the prior Office action, have been fully considered in light of applicant's amendment and are persuasive. The objections are been withdrawn.

6. Applicant's arguments filed June 14, 2006, with respect to the rejections set-forth in the prior Office action, have been fully considered but they are not persuasive.

A. Applicant argues:

> One of ordinary skill in the art would have no motivation to combine the teachings of these references. JP 3-100561 is directed to an electrophotographic toner. The Examiner has pointed to nothing in the teachings of this reference that would suggest to one of ordinary skill in the art that it would be desirable to use a marking material as disclosed therein in a ballistic aerosol marking device. Neither of the cited references suggests or teaches the desirability of combining the elements of the present invention as claimed.

The examiner disagrees. Peeters broadly teaches a toner [3:28-33] and does not limit the invention: neither prescribing nor proscribing any one toner exclusively. A reference is part of the literature of the art, relevant for all it contains, and may be relied upon for all that it would have reasonably suggested to one having ordinary skill in the art.[1] Further, disclosed examples and preferred embodiments do not constitute a teaching away from a broader disclosure.[2] In considering the disclosure of a reference, it is proper to take into account not only specific teachings of the reference but also the inferences which one skilled in the art would reasonably be expected to draw therefrom.[3] Because Peeters is silent with respect to the particular toner composition, one of ordinary skill in the art would have looked to the prior art to find a suitable composition. The selection of a known material based on its suitability for its intended use has been held to support a *prima facie* case of obviousness.[4] Applicant's argument merely contradicts this position of the examiner, but does not address it directly. Consequently, this argument is not persuasive.

B. Applicant argues:

> In addition, even if these references were combined as suggested by the Examiner, neither reference teaches or suggests the preparation of a marking material by an emulsion aggregation process. Accordingly, even if these references were combined as suggested, one of ordinary skill in the art would not arrive at the instant invention.

The examiner disagrees. JP '561 clearly teaches polymerization in an "emulsion suspension" which, because applicant's specification provides no definition of "an emulsion aggregation process" that excludes such a process such as this one taught by JP '561, reads on the claimed invention. Applicant is reminded that the presumption of a claim term's

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[1] MPEP § 2123(I)
[2] MPEP § 2123(II)
[3] MPEP § 2144.01
[4] MPEP § 2144.07

carrying the ordinary and customary meaning is rebutted only when applicant, acting as his or her own lexicographer, has clearly set forth a definition of the term different from its ordinary and customary meaning.[5] Consequently, this argument is not persuasive.

C. Applicant argues:

> In addition, Applicants point out that Japanese Patent 3-100561 teaches a toner having a high polymer adhered to the surface of the core. Nothing in this reference teaches or suggests a toner as recited in claim 17, comprising particles of a resin and an optional colorant, said toner particles having coated thereon a polypyrrole, said polypyrrole having no more than about 100 repeat monomer units. Accordingly, Applicants are of the position that this claim is particularly patentable with respect to the teachings of this reference.

Applicant appears to be arguing that a "high polymer," as disclosed by JP '561 is a polymer having more than about 100 repeat monomer units. This argument is not persuasive because there is no evidence of record establishing the definition of a "high polymer" and that applicant's polypyrrole having not more than about 100 repeat monomer units is exclusive of a "high polymer" so defined.

Further, Alger's *Polymer Science Dictionary*, 2nd Edition[6], defines a "high polymer" as:

> A polymer having a high degree of polymerization (DP) and hence of a high molecular mass. "High" is often interpreted as meaning a sufficiently high DP so that the effects of end groups may be ignored. ...Typically this means a polymer with a DP of more than about 100.

Alger defines "degree of polymerization" as:

> The number of repeat units (M) in an individual polymer molecule, i.e. the value of *n* in the generalized formula of a polymer molecule $\{M\}_n$.

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[5] *Brookhill-Wilk 1 LLC v. Intuitive Surgical, Inc.*, [67 USPQ2d 1132] (CAFC 2003), citations omitted.
[6] Alger, Mark, ed., *Polymer Science Dictionary*, 2nd Edition, © 1989 Chapman & Hall, 1997 Mark Alger, copy provided at applicant's request.

Hence, the ordinary and conventional meaning of the term "high polymer" is inclusive of polymers having "about 100 monomer units."

Claim Rejections - 35 USC § 103

7. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

8. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

9. **Claims 1-3, 6-9, 16, 17, and 22-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Peeters et al. (US 6,328,409 B1) in view of JP 03-100561. Both of these references were cited in the IDS filed January 21, 2004, including an English-language translation of the JP document.**

A. These claims are rejected for the same reasons as set-forth under this heading in the prior Office action.

10. **Claims 10-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Peeters et al. and JP '561, as applied to claim 1 above, and further in view of Patel et al. (US 5,403,693 A).**

A. These claims are rejected for the same reasons as set-forth under this heading in the prior Office action.

11. **Claims 20 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Peeters et al. and JP '561, as applied to claim 1 above, and further in view of Sacripante et al. (US 5,348,832 A).**

A. These claims are rejected for the same reasons as set-forth under this heading in the prior Office action.

Conclusion

12. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

13. The prompt development of clear issues in the prosecution history requires that applicant's reply to this Office action be fully responsive (MPEP § 714.02). When filing an amendment, applicant should specifically point out the support for any amendment made to the disclosure, including new or amended claims (MPEP §§ 714.02 & 2163). A fully responsive reply to this Office action, if it includes new or amended claims, must therefore

include an explicit citation (i.e., page number and line number) of that/those portion(s) of the original disclosure which applicant contends support(s) the new or amended limitation(s).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William P. Fletcher III whose telephone number is (571) 272-1419. The examiner can normally be reached on Monday through Friday, 0900h-1700h.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Timothy H. Meeks can be reached on (571) 272-1423. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

William Phillip Fletcher III
Patent Examiner (FSA), USPTO
Art Unit 1762

Fredericksburg, VA
August 17, 2006